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EXAMINER	
NAJARIAN, LENA	

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/774,791	NEUMAN ET AL.	
	Examiner	Art Unit	
	Lena Najarian	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 February 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-88* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-88* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 February 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20010809*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: item 214 (Fig. 2). Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 and 24-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1-19 and 24-37 recite the limitations for which there is no antecedent basis in the claims. In particular, the following passages lack or have vague antecedent basis:

(i) "the user": claim 1, line 5

claim 12, line 2

claim 15, line 2

claim 24, line 1

claim 25, lines 7 & 9

claim 27, line 4

claim 29, line 4

claim 33, line 4

claim 35, line 4

claim 36, line 8

(ii) Claims 2-11, 13-14, 16-19, 26, 28, 30-32, 34, and 37 incorporate the deficiencies of claims 1, 25, and 36, through dependency, and are also rejected.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 9-10, 14-21, 23-27, 29-53, 55-58, 62-63, 65-68, and 71-88 are rejected under 35 U.S.C. 102(e) as being anticipated by Goetz et al. (US 6,421,650 B1).

(A) Referring to claim 1, Goetz discloses a method comprising:

entering via an electronic prescription creation device a drug for a prescription (abstract, lines 1-12 of Goetz; the Examiner interprets "medication management system" to be a form of "prescription creation device");

viewing a drug use evaluation alert on a graphical user interface of the electronic prescription creation device (abstract, lines 19-25 & col. 4, lines 50-52 of Goetz);

viewing on the graphical user interface a query of whether the user desires to override the drug use evaluation alert; and

entering via the electronic prescription creation device an override of the drug use evaluation alert (col. 12, lines 3-10 of Goetz).

(B) Referring to claim 2, Goetz discloses viewing on the graphical user interface a plurality of representations each corresponding to a motive for overriding the drug use evaluation alert (col. 16, lines 42-47 of Goetz; the Examiner interprets "a specific caution note" to be a form of "motive").

(C) Referring to claim 9, Goetz discloses selecting via the electronic prescription creation device at least one of the plurality of representations (Fig. 19 & Fig. 20 of Goetz).

(D) Referring to claim 10, Goetz discloses completing the prescription with the electronic prescription creation device (col. 11, lines 24-26 of Goetz; the Examiner interprets "taps on 'Done'" to be a form of "completing").

(E) Referring to claim 14, Goetz discloses the prescription being an electronic prescription (Fig. 22 of Goetz).

(F) Referring to claim 15, Goetz discloses the electronic prescription including information communicating that the user has overridden the drug use evaluation alert (col. 16, lines 42-47 of Goetz; the Examiner interprets "a specific caution note" to be a form of "information communicating that the user has overridden the drug use evaluation alert").

(G) Referring to claim 16, Goetz discloses the information including the drug use evaluation alert (abstract, lines 29-31 of Goetz).

(H) Referring to claim 17, Goetz discloses the drug use evaluation alert being:

a drug-allergy alert (col. 10, lines 7-9 of Goetz);

a drug-drug interaction alert (abstract, lines 29-31 of Goetz);

a drug-food interaction alert (col. 4, lines 62-65 of Goetz); and

an alcohol conflict alert (col. 4, lines 62-65 of Goetz);

(I) Referring to claim 18, Goetz discloses entering via the electronic prescription creation device a reason for overriding the drug use evaluation alert (col. 16, lines 42-47 of Goetz; the Examiner interprets "note" to be a form of "reason").

(J) Referring to claim 19, Goetz discloses the electronic prescription creation device being a personal digital assistant (col. 5, lines 36-40 of Goetz).

(K) Referring to claim 20, Goetz discloses a method comprising:

entering via an electronic prescription creation device configured to create prescriptions a drug for a patient's prescription (abstract, lines 8-12 of Goetz);

viewing a drug use evaluation alert on a graphical user interface of the electronic prescription creation device (abstract, lines 19-25 & col. 4, lines 50-52 of Goetz); and

entering via the electronic prescription creation device a reason for overriding the drug use evaluation alert (col. 16, lines 42-47 of Goetz).

(L) Referring to claim 21, Goetz discloses viewing on the graphical user interface a plurality of representations each corresponding to a motive for overriding the drug use evaluation alert, the entering via the electronic prescription creation device the reason for overriding the drug use evaluation alert including selecting via the electronic prescription creation device at least one of the plurality of representations (col. 16, lines 42-47, Fig. 19, and Fig. 20 of Goetz).

(M) Referring to claim 23, Goetz discloses completing the prescription with the electronic prescription creation device, the prescription being at least one of a paper prescription and an electronic prescription, the prescription including information communicating the drug use evaluation alert (col. 11, lines 24-51 & col. 16, lines 42-47 of Goetz).

(N) Referring to claim 24, Goetz discloses the prescription including an indication that the user has overridden the drug use evaluation alert (col. 16, lines 42-47 of Goetz).

(O) Claim 25 differs from method claim 1 by reciting "a computer-readable medium having instructions stored thereon" within its preamble. As per these elements, Goetz's

medication management system includes a smart card reader and a software application on a personal computer, which reads data from the memory device (col. 5, lines 36-64 of Goetz). As such, it is readily apparent that Goetz's medication management system is controlled by instructions stored upon a computer-readable medium.

The remainder of claim 25 repeats the same limitations of method claim 1, and is therefore rejected for the same reasons given above for claim 1, and incorporated herein.

(P) Referring to claim 26, Goetz discloses the instructions when executed by the electronic prescription creation device further causing the electronic prescription creation device to:

present on the graphical user interface a plurality of motives for overriding the drug use evaluation alert (col. 16, lines 42-47 of Goetz).

(Q) Referring to claim 27, Goetz discloses the instructions when executed by the electronic prescription creation device further causing the electronic prescription creation device to:

receive from the user a reason for overriding the drug use evaluation alert, the reason for overriding the drug use evaluation alert being at least one of the plurality of motives presented on the graphical user interface (col. 16, lines 42-47 of Goetz).

(R) Claim 29 differs from method claim 24 by reciting "a computer-readable medium" within its preamble. As per these elements, Goetz's medication management system includes a smart card reader and a software application on a personal computer, which

reads data from the memory device (col. 5, lines 36-64 of Goetz). As such, it is readily apparent that Goetz's medication management system is controlled by instructions stored upon a computer-readable medium.

The remainder of claim 29 repeats the same limitations of method claim 24, and is therefore rejected for the same reasons given above for claim 24, and incorporated herein.

(S) Referring to claim 30, Goetz discloses the instructions when executed by the electronic prescription creation device further causing the electronic prescription creation device to:

· include with the prescription the drug use evaluation alert (col. 16, lines 42-47 of Goetz).

(T) Claim 31 differs from method claim 14 by reciting "a computer-readable medium" within its preamble. As per these elements, Goetz's medication management system includes a smart card reader and a software application on a personal computer, which reads data from the memory device (col. 5, lines 36-64 of Goetz). As such, it is readily apparent that Goetz's medication management system is controlled by instructions stored upon a computer-readable medium.

The remainder of claim 31 repeats the same limitations of method claim 14, and is therefore rejected for the same reasons given above for claim 14, and incorporated herein.

(U) Referring to claim 32, Goetz discloses the prescription being a paper prescription (col. 11, lines 48-51 of Goetz).

(V) Referring to claim 33, Goetz discloses the instructions when executed by the electronic prescription creation device further causing the electronic prescription creation device to:

receive from the user a reason for overriding the drug use evaluation alert (col. 16, lines 42-47 of Goetz).

(W) Referring to claim 34, Goetz discloses the instructions when executed by the electronic prescription creation device further causing the electronic prescription creation device to:

communicate to a workstation via a network the reason for overriding the drug use evaluation alert (col. 16, lines 42-47 & col. 6, lines 1-9 of Goetz).

(X) Referring to claim 35, Goetz discloses the instructions when executed by the electronic prescription creation device further causing the electronic prescription creation device to:

communicate to a workstation via a network an indication that the user has overridden the drug use evaluation alert (col. 6, lines 1-9 & col. 16, lines 42-47 of Goetz).

(Y) Referring to claim 36, Goetz discloses the instructions when executed by an electronic prescription creation device cause the electronic prescription creation device to:

create a prescription for a patient (Fig. 20 of Goetz);

present on a graphical user interface of the electronic prescription creation device a plurality of representations each corresponding to a motive for overriding a drug use evaluation alert (col. 16, lines 42-47 of Goetz); and

receive from the user a selection of one of the plurality of representations (Fig. 19 of Goetz).

(Z) Referring to claim 37, Goetz discloses the instructions when executed by the electronic prescription creation device further causing the electronic prescription creation device to:

communicate to a workstation via a network the selection of one of the plurality of representations (Fig. 18, Fig. 19, & col. 12, lines 56-59 of Goetz; the Examiner interprets "Internet" to be a form of "network").

(AA) Claim 38 repeats the same limitations of claim 24, and is therefore rejected for the same reason given for that claim.

(BB) Claim 39 repeats the same limitations of claim 33, and is therefore rejected for the same reason given for that claim.

(CC) Referring to claim 40, Goetz discloses the reason being received by a service provider of software for the electronic device (col. 5, lines 56-64 of Goetz).

(DD) Referring to claim 41, Goetz discloses receiving a prescription created with the electronic device (Fig. 20 of Goetz);

conducting a drug use evaluation for the received prescription to obtain another drug use evaluation alert; and

determining whether the user has overridden the another drug use evaluation alert based on the received indication (col. 12, lines 3-21 of Goetz).

(EE) Referring to claim 42, Goetz discloses the indication being received by a pharmacy (col. 6, lines 1-9 of Goetz).

(FF) Referring to claim 43, Goetz discloses further comprising forwarding the indication to at least one of a pharmacy benefit management company and a claims processor (col. 2, lines 22-27 of Goetz; the Examiner interprets "insurance providers" to be a form of "claims processor").

(GG) Claim 44 repeats the same limitations of claim 40, and is therefore rejected for the same reason given for that claim.

(HH) Referring to claim 45, Goetz discloses a computer data signal embodied in a transmission medium comprising (Fig. 1, col. 4, lines 17-33, & col. 8, lines 59-65 of Goetz):

computer-readable program code for causing an electronic prescription creation device to present a user of the electronic prescription creation device a drug use evaluation alert (col. 12, lines 12-21 & 51-59 of Goetz); and

computer-readable program code for causing the electronic prescription creation device to query whether the user desires to override the drug use evaluation alert; and

computer-readable program code for causing the electronic prescription creation device to receive an override of the drug use evaluation alert (Fig. 23, Fig. 24, and col. 11, lines 29-39 of Goetz).

(II) Claim 46 repeats the same limitations of claim 26, and is therefore rejected for the same reasons given for that claim.

(JJ) Referring to claim 47, Goetz discloses an electronic device configured to create prescriptions, the electronic device including means for querying whether the user desires to override the drug use evaluation alert, the electronic device including means for receiving an override of the drug use evaluation (Fig. 23 & Fig. 24 of Goetz).

(KK) Referring to claim 48, Goetz discloses means for receiving a reason for overriding the drug use evaluation alert (col. 16, lines 42-47 of Goetz).

(LL) Referring to claim 49, Goetz discloses computer executable software code stored on a computer readable medium of an electronic prescription creation device, the code for generating a graphical user interface, the graphical user interface comprising (col. 12, lines 51-59 & col. 4, lines 50-52; the Examiner interprets "software routine" to be a form of "software code"):

at least one representation querying whether the user desires to override the drug use evaluation alert (col. 11, lines 29-39 of Goetz).

(MM) Referring to claim 50, Goetz discloses at least one representation corresponding to a motive for overriding the drug use evaluation alert (col. 16, lines 42-47 of Goetz).

(NN) Referring to claim 51, Goetz discloses a method comprising:

entering via a an electronic prescription creation device a drug for a prescription of a patient (abstract, lines 8-12 of Goetz);

viewing on a graphical user interface of the electronic prescription creation device a query of whether the drug is to be dispensed as written; and

entering via the electronic prescription creation device an indication that the drug is to be dispensed as written; and

entering via the electronic prescription creation device a reason why the drug is to be dispensed as written (col. 11, lines 29-39 & col. 12, lines 12-21 of Goetz).

(OO) Referring to claim 52, Goetz discloses viewing on the graphical user interface a plurality of representations each corresponding to a motive for dispensing the drug as written (col. 12, lines 12-21 of Goetz).

(PP) Referring to claim 53, Goetz discloses viewing on the graphical user interface a plurality of representations each corresponding to a motive for dispensing the drug as written (col. 16, lines 42-47 of Goetz).

(QQ) Referring to claim 55, Goetz discloses the plurality of representations including a representation that the drug is medically necessary (col. 15, lines 10-13 of Goetz; the Examiner interprets "must be administered" to be a form of "medically necessary").

(RR) Referring to claim 56, Goetz discloses the plurality of representations including a representation that a patient requests the drug (col. 8, lines 5-13 of Goetz).

(SS) Referring to claim 57, Goetz discloses entering via the electronic prescription creation device an indication representing that the drug is to be dispensed as written including selecting an icon on the graphical user interface (Fig. 24 of Goetz).

(TT) Claim 58 repeats the same limitations of claim 10, and is therefore rejected for the same reasons given for that claim.

(UU) Claim 62 repeats the same limitations of claim 14, and is therefore rejected for the same reasons given for that claim.

(VV) Referring to claim 63, Goetz discloses the electronic prescription including information communicating the reason why the drug is to be dispensed as written (col. 16, lines 42-47 of Goetz).

(WW) Referring to claim 65, Goetz discloses a method comprising:

entering via a an electronic prescription creation device a drug for a prescription of a patient (abstract, lines 8-12 of Goetz);

viewing on a graphical user interface of the electronic prescription creation device a plurality of representations each corresponding to a motive for dispensing the drug as written (col. 12, lines 12-21 of Goetz); and

entering via the electronic prescription creation device a reason why the drug is to be dispensed as written (col. 16, lines 42-47 of Goetz).

(XX) Referring to claim 66, Goetz discloses the entering via the electronic prescription device a reason why the drug is to be dispensed as written including selecting at least one of the plurality of representations (col. 16, lines 42-47 of Goetz).

(YY) Referring to claim 67, Goetz discloses the plurality of representations including at least:

a representation that the drug is medically necessary (col. 15, lines 10-13 of Goetz); and

a representation that the patient requested the drug (col. 8, lines 5-13 of Goetz).

(ZZ) Referring to claim 68, Goetz discloses completing the prescription with the electronic prescription creation device, the prescription being at least one of a paper prescription and an electronic prescription and including information communicating the

reason why the drug is to be dispensed as written (col. 11, lines 48-51, Fig. 22, and col. 16, lines 42-47 of Goetz).

(AAA) Referring to claim 71, Goetz discloses the instructions when executed by an electronic device cause the electronic device to:

create a prescription for a drug (Fig. 14 of Goetz); and

receive from a user of the electronic device a reason why the drug is to be dispensed as written (col. 16, lines 42-47 of Goetz).

(BBB) Referring to claim 72, Goetz discloses the instructions when executed by the electronic device further causing the electronic device to:

present on a graphical user interface of the electronic device a plurality of representations each corresponding to a motive for dispensing the drug as written (col. 16, lines 42-47 of Goetz).

(CCC) Referring to claim 73, Goetz discloses the reason for overriding the drug use evaluation alert being at least one of the plurality of representations presented on the graphical user interface (col. 16, lines 42-47 of Goetz).

(DDD) Claim 74 differs from method claim 67 by reciting "a computer-readable medium" within its preamble. As per these elements, Goetz's medication management system includes a smart card reader and a software application on a personal computer, which reads data from the memory device (col. 5, lines 36-64 of Goetz). As such, it is readily apparent that Goetz's medication management system is controlled by instructions stored upon a computer-readable medium.

The remainder of claim 74 repeats the same limitations of method claim 67, and is therefore rejected for the same reasons given above for claim 67, and incorporated herein.

(EEE) Referring to claim 75, Goetz discloses the instructions when executed by the electronic device further causing the electronic device to:

include with the prescription the reason why the drug is to be dispensed as written (col. 12, lines 12-21 of Goetz).

(FFF) Claim 76 differs from method claim 14 by reciting "a computer-readable medium" within its preamble. As per these elements, Goetz's medication management system includes a smart card reader and a software application on a personal computer, which reads data from the memory device (col. 5, lines 36-64 of Goetz). As such, it is readily apparent that Goetz's medication management system is controlled by instructions stored upon a computer-readable medium.

The remainder of claim 76 repeats the same limitations of method claim 14, and is therefore rejected for the same reasons given above for claim 14, and incorporated herein.

(GGG) Claim 77 repeats the same limitations of claim 32, and is therefore rejected for the same reasons given for that claim.

(HHH) Referring to claim 78, Goetz discloses the instructions when executed by the electronic prescription creation device further causing the electronic prescription creation device to:

communicate to a workstation via a network the reason why the drug is to be dispensed as written (Fig. 1 & col. 12, lines 12-21 of Goetz).

(III) Referring to claim 79, Goetz discloses receiving from an electronic device configured to create prescriptions a reason why a drug of a prescription created by the electronic device is to be dispensed as written (col. 12, lines 12-21 of Goetz).

(JJJ) Claim 80 repeats the same limitations of claim 40, and is therefore rejected for the same reasons given for that claim.

(KKK) Claims 81-82 repeat the same limitations of claims 42-43, and are therefore rejected for the same reasons given for those claims.

(LLL) Referring to claim 83, Goetz discloses further comprising receiving the prescription (col. 2, lines 63-67 of Goetz).

(MMM) Referring to claim 84, Goetz discloses a computer data signal embodied in a transmission medium comprising (Fig. 1, col. 4, lines 17-33, & col. 8, lines 59-65 of Goetz):

computer-readable program code for causing the electronic prescription creation device to query whether the user desires to dispense a drug as written; and

computer-readable program code for causing the electronic prescription creation device to receive a reason why the drug is to be dispensed as written (col. 11, lines 29-39 and col. 12, lines 12-21 of Goetz).

(NNN) Referring to claim 85, Goetz discloses a computer-readable program code for causing the electronic prescription creation device to present a plurality of

representations each corresponding to a motive for dispensing the drug as written (col. 12, lines 12-21 of Goetz).

(OOO) Referring to claim 86, Goetz discloses an electronic device configured to create prescriptions, the electronic device including means for receiving a reason why a user of the electronic device requests that a drug for a prescription is to be dispensed as written (col. 12, lines 12-21 of Goetz).

(PPP) Referring to claim 87, Goetz discloses the electronic device further comprising means for including the reason with a prescription created with the electronic device (col. 16, lines 42-47 of Goetz; the Examiner interprets "note" to be a form of "reason").

(QQQ) Referring to claim 88, Goetz discloses a plurality of representations each corresponding to a motive for dispensing a drug as written, each of the representations being selectable by a user of the electronic device (Fig. 19, Fig. 20, and col. 16, lines 42-47 of Goetz).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 3-8, 22, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650 B1) as applied to claims 1-2, 20-21, and 25-26 above, and further in view of Edelson et al. (5,737,539).

(A) Referring to claims 3-8, Goetz does not disclose the plurality of representations including: a representation that a patient is no longer taking a conflicting drug, a representation that a patient is stabilized on the drug for the prescription, a representation that a patient is not allergic to the drug for the prescription, a representation that a dosage of the drug is appropriate for a patient's weight, a representation that a dosage of the drug is appropriate for a patient's condition, and a representation that a patient is not pregnant.

Edelson discloses a representation that a patient is no longer taking a conflicting drug (col. 31, lines 39-46 if Edelson; the Examiner interprets "expired prescriptions" to be a form of "no longer taking"), a representation that a patient is stabilized on the drug for the prescription (col. 31, lines 39-46 of Edelson), a representation that a patient is not allergic to the drug for the prescription (col. 31, lines 25-32 of Edelson), a representation that a dosage of the drug is appropriate for a patient's weight (col. 25, line 64 – col. 26, line 10 of Edelson), a representation that a dosage of the drug is appropriate for a patient's condition (col. 2, lines 18-24 of Edelson), and a representation that a patient is not pregnant (col. 25, line 64 – col. 26, line 10 of Edelson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Edelson within Goetz. The motivation for doing so would have been to screen for possible unintended adverse outcomes and to provide special precautions regarding a prescribed drug's use (col. 30, lines 58-60 of Edelson).

(B) Referring to claim 22, Goetz does not disclose the plurality of representations including at least one of the following: a representation that the patient is no longer taking a conflicting drug a representation that the patient is stabilized on the drug for the prescription; a representation that the patient is not allergic to the drug for the prescription; a representation that a dosage of the drug is appropriate for the patient's weight; a representation that the dosage of the drug is appropriate for the patient's condition; a representation that the patient is not pregnant; a representation of a narrow therapeutic drug index; a representation that a concurrent diagnosis prohibits another selection; a representation of a failed therapy; and a representation that the patient is unable to take another selection.

Edelson discloses the plurality of representations including: a representation that the patient is no longer taking a conflicting drug (col. 31, lines 39-46 of Edelson); a representation that the patient is stabilized on the drug for the prescription (col. 31, lines 39-46 of Edelson); a representation that the patient is not allergic to the drug for the prescription (col. 31, lines 25-32 of Edelson); a representation that a dosage of the drug is appropriate for the patient's weight (col. 25, line 64 – col. 26, line 10 of Edelson); a representation that the dosage of the drug is appropriate for the patient's condition (col. 2, lines 18-24 of Edelson); and a representation that the patient is not pregnant (col. 25, line 64 – col. 26, line 10 of Edelson).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the features of Edelson within Goetz. The motivation for doing

so would have been to screen for possible unintended adverse outcomes and to provide special precautions regarding a prescribed drug's use (col. 30, lines 58-60 of Edelson).
(C) Claim 28 differs from method claim 22 by reciting a "computer-readable medium" within its preamble. As per these elements, Edelson's electronic prescription creation system includes a device that can interpret bar-coding (col. 29, lines 35-41 of Edelson). As such, it is readily apparent that Edelson's electronic prescription creation system includes a computer-readable medium.

The remainder of claim 28 repeats the same limitations of method claim 22, and is therefore rejected for the same reasons given above for claim 22, and incorporated herein.

9. Claims 11-13 and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650 B1) as applied to claims 1, 10, 51, and 58 above, and further in view of Liff et al. (5,797,515).
(A) Referring to claim 11, Goetz does not disclose the prescription being a paper prescription printed with a printer in communication with the electronic prescription creation device.

Liff discloses the prescription being a paper prescription printed with a printer in communication with the electronic prescription creation device (Fig. 1, item 56 and col. 5, lines 58-63 of Liff).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Liff within Goetz. The motivation for doing so

would have been to easily generate a document at a document printer containing additional instructions for the patient or practitioner (col. 5, lines 58-63 of Liff).

(B) Referring to claim 12, Goetz discloses the paper prescription including indicia thereon communicating that the user has overridden the drug use evaluation alert (col. 16, lines 42-47 of Goetz; the Examiner interprets "note" to be a form of "indicia").

(C) Referring to claim 13, Goetz discloses the indicia including the drug use evaluation alert (col. 16, lines 42-47 of Goetz; the Examiner interprets "describing the interaction" to be a form of "alert").

(D) Claim 59 repeats the same limitations of claim 11, and is therefore rejected for the same reasons given for that claim.

(E) Referring to claim 60, Goetz discloses the paper prescription including indicia thereon communicating the reason why the drug is to be dispensed as written (col. 16, lines 42-47 of Goetz; the Examiner interprets "note" to be a form of "reason").

10. Claims 54, 64, 69, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650 B1) as applied to claims 51-52, 58, 62-63, 65, and 67-68 above, and further in view of Adams (US 2002/0055856 A1).

(A) Referring to claim 54, Goetz does not disclose the plurality of representations including at least one NCPDP dispense as written code.

Adams discloses the plurality of representations including at least one NCPDP dispense as written code (para. 7 of Adams).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Adams within Goetz. The motivation for doing so would have been to provide a standard form of communication (para. 7, lines 7-16 of Adams).

(B) Claims 64, 69, and 70 repeat the same limitations of claim 54, and are therefore rejected for the same reasons given for that claim.

11. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (US 6,421,650 B1) in view of Liff et al. (5,797,515) as applied to claims 51, 58-60 above, and further in view of Adams (US 2002/0055856 A1).

(A) Referring to claim 61, Goetz and Liff do not disclose the indicia including a NCPDP dispense as written code.

Adams discloses the indicia including a NCPDP dispense as written code (para. 7 of Adams).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Adams within Goetz and Liff. The motivation for doing so would have been to provide a standard form of communication (para. 7, lines 7-16 of Adams).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a prescription management system (5,845,255).

Also included is provisional application 60/242,294, which is a priority document to applied reference US-2002/0055856 A1 (Adams).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is (703) 305-0260. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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